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#13

Birch, Stewart, Kolasch & Birch, LLP
P.O. Box 747
Falls Church, VA 22040-0747

In re Application of SACCO et al :
U.S. Application No.: 09/486,660 :
Int. Application No.: PCT/IT98/00231 :
Int. Filing Date: 11 August 1998 :
Priority Date: 28 August 1997 :
Attorney Docket No.: 471-129P (previously SCBREV-223) :
For: TRANSGENIC ANIMALS FOR THE STUDY OF :
BIOLOGICAL, PHYSICAL, AND CHEMICAL :
TOXIC AGENTS :

DECISION

This is in response to applicants' "Renewed Request for Status Under 37 CFR 1.42 and Renewed Petition Under 37 CFR 1.47(A)" filed 10 April 2002, requesting that the application be accepted for national stage processing without the signatures of legal representatives of certain heirs of joint inventor Romeo Roncucci, who is deceased.

BACKGROUND

On 11 August 1998, applicants filed international application PCT/IT98/0023, which claimed priority of an earlier Italy application filed 28 August 1997. A copy of the international application was communicated to the USPTO from the International Bureau on 11 March 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 25 March 1999, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 28 February 2000.

On 28 February 2000, applicants filed national stage papers in the United States. The submission was accompanied by, *inter alia*, the requisite basic national fee required by 35 U.S.C. 371(c)(1) and an unsigned declaration.

On 28 April 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), indicating that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 24 October 2000, applicants filed a request for status under 37 CFR 1.42, a petition under 37 CFR 1.47(a), a declaration executed by five of the six inventors, and declarations signed by certain legal representatives.

On 30 April 2001, this Office mailed a decision dismissing the request for status and petition.

On 28 September 2001, applicants filed a renewed request for status under 37 CFR 1.42 and a renewed petition under 37 CFR 1.47(a).

On 29 October 2001, applicants filed a supplemental renewed request for status under 37 CFR 1.42 and renewed petition under 37 CFR 1.47(a).

On 28 November 2001, this Office mailed a decision dismissing the 28 September 2001 renewed request for status and petition.

On 07 December 2001, applicants filed a supplemental renewed request for status under 37 CFR 1.42 and renewed petition under 37 CFR 1.47(a).

On 11 January 2002, this Office mailed a decision dismissing the 29 October 2001 and 07 December 2001 renewed requests for status and petitions.

On 10 April 2002, applicants filed the present renewed request for status under 37 CFR 1.42 and renewed petition under 37 CFR 1.47(a).

DISCUSSION

37 CFR 1.42 provides, "In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent." The response states that deceased inventor Romeo Roncucci has four heirs: Sylvie Roncucci, Rachele Roncucci, Regine Roncucci, and Roxanne Roncucci.

Effective 07 November 2000, 37 CFR 1.497(b)(2) specifies that, where a person making the declaration is the legal representative of a deceased inventor, the declaration shall state the following: (1) the relationship of the person to the inventor, (2) the facts the inventor would have been required to state, upon information and belief, (3) that the person is the legal representative of the deceased inventor, and (4) the citizenship, residence, and mailing address of the legal representative.

Sylvie Roncucci

The renewed petition states that Sylvie Roncucci refuses to sign the application papers.

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

Applicants have previously satisfied items (1) and (3) above.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

In the present case, applicants have demonstrated that a bona fide attempt was made to present a complete copy of the application papers to Sylvie Roncucci for signature. Specifically, the application papers were sent to Sylvie Roncucci on 19 November 2001 (see affidavit of Beatrice Salvador). In addition, applicants have sufficiently shown that Sylvie Roncucci refuses to sign the application papers. Specifically, Sylvie Roncucci made an express oral refusal during a telephone conversation with Ms. Salvador (see Salvador's affidavit). Furthermore, Sylvie Roncucci made an express written refusal to sign the application papers (see Sylvie Roncucci's letter dated 19 November 2001). Therefore, it can be concluded with reasonable certainty that Sylvie Roncucci refuses to join in the application.

With regard to item (4) above, applicants have provided the last known address of Sylvie Roncucci.

Rachele Roncucci and Regine Roncucci

37 CFR 1.43 provides, "In case an inventor is insane or otherwise legally incapacitated, the legal representative (guardian, conservator, etc.) of such inventor may make the necessary oath or declaration, and apply for and obtain the patent." Applicants have submitted a declaration signed by Maria Novella Castagnoli, guardian of Rachele Roncucci and Regine Roncucci, who according to the response are minors.

The 29 October 2001 declaration signed by Maria Novella Castagnoli is acceptable under 37 CFR 1.42, 37 CFR 1.43, and 37 CFR 1.497.

Roxanne Roncucci

The 07 December 2001 renewed petition states that applicants have been unable to obtain the signature of Anne Georgette Christiane Delachet, guardian of Roxanne Roncucci, who according to the response is a minor.

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

Applicants have previously satisfied items (1), (3), and (4) above.

With regard to item (2) above, applicants have demonstrated that a bona fide attempt was made to present a copy of the application papers (including specification, claims, drawings, and oath or declaration) to Ms. Delachet for signature. Specifically, a copy of the application papers was sent to Ms. Delachet on 25 September 2001 by courier (see 28 September 2001 affidavit of Peter Bromley). Courier records indicate that Ms. Delachet received the correspondence on 26 September 2001 (see copy of courier report for item number "4754533000"). In addition, applicants have sufficiently shown that Ms. Delachet refuses to sign the application papers. Specifically, Ms. Delachet has failed to respond to the 25 September 2001 letter. Therefore, it can be concluded with reasonable certainty that Ms. Delachet refuses to sign the application papers.

CONCLUSION

For the reasons above, the renewed request for status under 37 CFR 1.42 and the renewed petition under 37 CFR 1.47(a) are GRANTED.

This application has an international filing date of 11 August 1998 and a date under 35 U.S.C. 371 of 29 October 2001.

As set forth in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the nonsigning individuals at the last known addresses of record and will be published in the *Official Gazette*.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision.



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In re Application of SACCO et al
U.S. Application No.: 09/486,660
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Int. Filing Date: 11 August 1998
Priority Date: 28 August 1997
For: TRANSGENIC ANIMALS FOR THE STUDY
OF BIOLOGICAL, PHYSICAL, AND
CHEMICAL TOXIC AGENTS

Dear Sylvie Roncucci:

Romeo Roncucci is named as a joint inventor in the above-captioned United States national stage application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, Romeo Roncucci will be designated as an inventor.

As an heir of Romeo Roncucci, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost set forth in 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you choose to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

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Anne Georgette Cristiane Delachet
Avenue Brancolar 111/A
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Dear Ms. Delachet:

Romeo Roncucci is named as a joint inventor in the above-captioned United States national stage application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, Romeo Roncucci will be designated as an inventor.

As an heir of Romeo Roncucci, Roxanne Roncucci is entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost set forth in 37 CFR 1.19) or to make her position of record in the application. Alternatively, she may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from her. If she chooses to join in the application, counsel of record (see below) would presumably assist her. Joining in the application would entail the filing of an appropriate oath or declaration by her pursuant to 37 CFR 1.63.

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